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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/429,470 | 10/28/1999 | HONG HEATHER YU | 9432-000089 | 5971 |

7590 03/08/2004

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| EXAMINER |
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CALLAHAN, PAUL E

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| ART UNIT | PAPER NUMBER |
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2137

DATE MAILED: 03/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/429,470

Applicant(s)

YU, HONG HEATHER

Examiner

Paul E. Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 13, 16-19, 23 and 29-33 is/are rejected.
- 7) ☒ Claim(s) 7-11, 14, 15, 20-22 and 24-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-33 are pending in this application and have been examined.

Drawings

2. The drawings are objected to because of the items noted on PTO Form 948 enclosed with this Office Action. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1-6, 12, 13, 16, 19, and 23, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Powell et al. US 6,678,392 B2.

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As per claim 1, Powell teaches a computerized method (col. 3 lines 7-10) for authenticating an electronic file (abstract) comprising the steps of: receiving an electronic file and creating an object level representation of the graphical content (col. 2 lines 48-67), and adding authentication information to the electronic file based on the object level representation of the graphical content (col. 2 lines 48-67).

As per claim 2, Powell teaches the graphical content as having pixel bit values (col. 3 lines 30-35).

As per claim 3, Powell teaches converting the graphical content into a symbolic representation of the graphical content (col. 2 lines 48-67).

As per claim 4, Powell teaches defining nodes of the graphical content with specification symbols (col. 2 lines 48-56).

As per claim 5, Powell teaches defining the shape, size, color, and position of the nodes in (col. 2 lines 48-67).

As per claim 6, Powell teaches defining conditions and familial relationships between the nodes. (col. 6 lines 45-65, col. 3 lines 30-35, col. 2 lines 48-67).

As per claim 12, Powell teaches the step of authenticating the graphical content at the pixel level (col. 7 lines 35-50).

As per claims 13, 16, 19, and 23, Powell teaches the step of adding visible and or invisible authentication information to the graphical content (col. 2 lines 47-67).

As per claims 29-33, these claims represent the apparatus carrying out the method of claims 1 and 18 and are therefore rejected on the same basis as those claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell, Cullen et al. (US 5,335,290), and official Notice taken as detailed infra.

As per claim 17, Powell does not teach partitioning an electronic file into graphical content and textual content. However Cullen does teach this step. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this step into the system of Powell. The motivation to combine the teachings for these two references is found in Powell col. 1: lines 34-40 where he discusses the need for image authors to audit the usage of their works when published as parts of electronic documents.

As per claim 18, Powell teaches authentication of an image at a pixel level and an object level (col. 7 lines 1-16). However Powell does not explicitly teach transmitting the authenticated image or that the image is a binary graph. Official Notice may be taken that the step of transmitting an authenticated document or image is old and well known in the art, and that document image data that may include a binary graph is a concept old and well known in the art as well. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated these features into the method of Powell. It would have been advantageous to do so as transmission of authenticated documents implies utilization of the

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Internet for commercial sale of the authenticated image, and utilization of the authentication method of Powell to authenticate binary graph data would increase the utility and hence marketability of the system.

Allowable Subject Matter

8. Claims 7-11, 14, 15, 20-22, and 24-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

As per claim group 7-11, and 26, the prior art does not teach the limitations of claim 1 and sequential authentication of an object level representation by a textual authentication algorithm, as the Examiner understands the Applicant's use of the terms.

As per claims 14 and 15, the prior art does not teach the limitations of claim 1 and where the visible authentication data is a bounding box or a bar code.

As per claims 20-22, 24, 25, 27, and 28, the prior art does not teach the limitations of claims 19 and 23, and further operating on a truncated image in the manner of the applicant as found in claims 20 and 24.

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Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336.

The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

3/3/04

Paul Callahan


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100